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PATENT APPLICATION *4-104 NP*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Norihiko KANAE et al.

Group Art Unit: 2674

Application No.: 09/828,390

Examiner: H. TRAN

Filed: April 2, 2001

Docket No.: 109106

For: ELECTROPHORETIC DISPLAY DEVICE

REQUEST FOR RECONSIDERATION

RECEIVED

MAR 23 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Technology Center 2600

Sir:

In reply to the December 22, 2003, Office Action, reconsideration based on the following remarks is respectfully requested.

Applicants appreciate the courtesy shown by the Examiner during the March 18 telephone conference. Applicants separate record of the substance of the telephone conference is incorporated into the following remarks.

I. The Claims Satisfy All Formal Requirements

Claim 4 is objected to because of informalities. Specifically, the Examiner asserts that "claim I" should be changed to "claim 1." It is respectfully submitted that claim 4 does not contain the informality "claim I." Instead, claim 4 clearly recites a dependency on claim 1. Thus, it is respectfully submitted that claim 4 is in condition for allowance. Accordingly, withdrawal of the objection is respectfully requested.

II. The Claims Define Allowable Subject Matter

The Office Action rejects claims 1-8 under 35 U.S.C. §102(a) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,400,492 to Morita. This rejection is respectfully traversed.

Morita does not constitute prior art under any of the subsections of 35 U.S.C. §102. Specifically, the priority documents of the present application pre-date the U.S. filing date of Morita. Enclosed is a signed translation of the priority claimed Japanese Patent Application No. 11-224203, filed on August 6, 1999, in the Japanese Patent Office. Furthermore, the December 22, 2003, Office Action acknowledges receipt of certified copies of the priority documents.

See 35 U.S.C. §102 in which it is stated, that,

[a] person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Thus, as discussed above, Morita is disqualified as prior art under 35 U.S.C. §102 because the priority documents of the present application pre-date the U.S. filing date of Morita.

As such, the Office Action fails to assert all of the features of the claimed invention. Thus, for at least the reasons discussed above, it is respectfully submitted that the independent claims are distinguishable over the applied art. Furthermore, those claims which depend from the independent claims are likewise distinguishable over the applied art for at least the reasons discussed above, as well as for the additional features they recite. Accordingly, withdrawal of the rejection under 35 U.S.C. §§102 and 103 is respectfully requested.

III. The Claims Satisfy All §112 Requirements

The Office Action admits that the applied art does not teach that a urethane resin whose molecular weight is between 5,000 to 2,000,000 is used in the resin layer; however, appears to question why the range is important to the claimed invention.

35 U.S.C. §112 states that the specification shall conclude with claims that particularly point out and distinctly claim the subject matter which applicants regard as the invention. Furthermore, MPEP §2173.04 states that breadth of a claim is not to be equated with indefiniteness and that a claim is definite so long as the scope of the claim is clearly defined.

The specification discloses that

The water-soluble urethane resin has a molecular weight of 5,000 to 2,000,000 or so, preferably 10,000 to 1,000,000 or so. If the molecular weight is smaller than this range, the water resistance, etc. falls, while conversely if larger, the pliability, etc. tends to fall (page 17, lines 4-8).

In this case, the scope of the subject matter embraced by claim 8 is clear, precise and unambiguous. Thus, it is respectfully submitted that claim 8 satisfies 35 U.S.C. §112 and thus, is in condition for allowance.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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JAO:JLC/cmf

Attachments:

Signed Translation of Priority Document
Japanese Patent Application No. 11-224203

Date: March 22, 2004

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